

### **DETAILED ACTION**

The receipt is acknowledged of applicants' response filed 12/18/2009.

The final office action mailed 11/18/2009 has been withdrawn, and new final office action is hereby issued.

The form paragraph concerning common ownership was inadvertently not removed from the office action mailed 11/18/2009. The USC 103 (a) rejection is maintained, and the examiner will respond to applicants' argument filed 12/18/2009.

Claims 1-34 have been canceled.

Claims 35-40 are pending and included in the prosecution.

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 07/13/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 7,435,424 has been reviewed and is accepted. The terminal disclaimer has been recorded.

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**The following rejections have been overcome by virtue of applicants' amendment and remarks:**

(A) Rejection of claims 35-40 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

(B) Rejection of claims 35-40 under 35 U.S.C. 112, first paragraph, as lacking enablement.

(C) Rejection of claims 35-40 under 35 U.S.C. 112, second paragraph, as being indefinite

**The following rejection has been discussed in details in the previous office action, and is maintained for reasons of record:**

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 35-40 are rejected under 35 U.S.C. 103(a) as being obvious over FR 2471775 ('775) combined with US 6,280,746 ('746).

FR '775 teaches cosmetic composition comprising mixture of jojoba oil and sunflower oil, and from 20-40% unsaponifiables oils fractions (page 4, 3<sup>rd</sup> paragraph). The unsaponifiable fraction includes residual part of saponifiable components and unsaponifiable fraction, with the unsaponifiable ingredients is greater than 40% (paragraph bridging pages 4 and 5). The cosmetic composition can be in the form of gel (last paragraph of page 5). Examples 3-5 and 7 showed composition comprising gelling agent Caropol 940, which is an acidic gelling agent.

Although FR '775 teaches composition comprising saponifiable and unsaponifiable fractions obtained from vegetable oils and suggested jojoba oil, however, the reference does not explicitly teach hydrolysis of the oil.

US '746 teaches cosmetic composition comprising jojoba oil ester (abstract). When applied to the skin, the cosmetic composition comprising jojoba oil ester prevents and retains natural moisture level of the skin (col.8, lines 18-24). The composition comprising jojoba oil esters from the trade name Floraesters-15, 20, 30, 60 70 (col.8, lines 35-40). The reference disclosed that jojoba esters are catalyzed, i.e. hydrolyzed, using alkali metal hydroxide, as applicants had done (col.3, lines 53-60). The reference disclosed gel comprising Carbopol (example 2). The Floraester disclosed by the reference are expected to have polar hydrophilic salt and non-polar unsaponifiable fractions of jojoba oil, and expected to comprise more than 10% long chain carbon material prior to hydrolysis. Hydrolyzed jojoba esters are produced using potassium hydroxide, and therefore they are alkaline and expected to be capable to neutralize acidic gelling agent.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide gel cosmetic composition comprising saponifiable and unsaponifiable oil fractions as taught by FR '775, and select jojoba oil suggested by the reference and further use hydrolyzed jojoba oil esters as taught by US '746. One would have been motivated to do so because US '746 teaches that cosmetic composition comprising hydrolyzed jojoba ester when applied to the skin prevents and retains natural moisture level of the skin. One would have reasonably expected

formulating gel cosmetic composition comprising hydrolyzed jojoba oil comprising saponifiable and unsaponifiable fractions wherein the composition prevents and retains natural moisture level on application to the skin.

### ***Response to Arguments***

6. Applicant's arguments filed 12/18/2009 have been fully considered but they are not persuasive.

The examiner maintains here that Arquette is qualified as prior art because it has different inventive entity and it does not disclose the subject matter of the present invention directed to "method of providing a composition for topical application, wherein said composition increases substantivity". See *In re Chu* (CAFC) 36 USPQ2d 1089 (1995). Furthermore, the present application is a CIP of patent 7,435,424 that does not disclose the limitation of the "gel" of subject matter of the present claims. Therefore, the instant claims do not qualify to the priority date 01/03/2000 of 7,435,424 patent. The instant method steps qualify to priority date 06/30/2003, filing date of the present application. Accordingly, Arquette patent that is issued August 28, 2001 has 35 U.S.C. 102 (b) date, and not 35 U.S.C. 102 (e) date, hence qualifies under 35 U.S.C. 103 (a).

Applicants argue that Arquette does not describe hydrolysis of jojoba oil wax esters as claimed by Applicants. Arquette instead describes a trans-esterification (i.e., alcoholysis), and not saponification reaction between jojoba oil and an alcohol which yield entirely different products. More specifically, hydrolysis of the ester forms soaps,

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which eliminates the possibility of reassembly of the ester linkage to generate a randomized, inter-esterified wax ester, as in the trans-esterification reaction (i.e., "alcoholysis"). Therefore, Arquette fails to provide the above-noted deficiency of FR 2471775 with respect to the independent claims.

In response to this argument, it is argued that Arquette teaches cosmetic composition comprising jojoba oil ester from the trade name Floraesters-15, 20, 30, 60 70, which applicant used in their examples. The reference disclosed that jojoba esters are catalyzed, i.e. hydrolyzed, using alkali metal hydroxide, as applicants had done. The Floraester disclosed by the reference are expected to have polar hydrophilic salt and non-polar unsaponifiable fractions of jojoba oil, and expected to comprise more than 10% long chain carbon material prior to hydrolysis. Hydrolyzed jojoba esters are produced using potassium hydroxide, and therefore they are alkaline and expected to be capable to neutralize acidic gelling agent. Non-saponifiable oils are taught by the primary reference FR '775, and Arquette is relied upon for teaching hydrolysis of unsaponifiable oil. Arquette teaches "alcoholysis" catalyzed by base. Applicant's attention is directed to the scope of the present claims that are directed to nominal method of providing a topical composition, and all the elements of the composition are taught by the combined teaching of the references. Further the claims' language does not exclude of alcoholysis. Arquette teaches alkali metal hydroxide in alcohol solution to obtain jojoba wax ester. The invention as a whole as recited by the present claims is taught by the combined teachings of the prior art, and would have been prima facie obvious in the meaning of USC 103 (a).

Applicants argue that Arquette teaches away from use of the alkaline catalyst to neutralize an acidic gelling agent. Arquette provides that "any remaining catalyst can be neutralized and deactivated by the addition of citric acid" (Col. 5, lines 25-27). Thus, rather than serving as a neutralizer, the alkaline catalyst is itself neutralized. The alkaline catalyst is neutralized by the addition of citric acid, not the acidic gelling agent. Moreover, at Col. 12, lines 6-7, Arquette provides that a "pH adjustment to between about 6.8-7.2 was useful", i.e., that there has to be an adjustment to neutralization, rather than neutralization occurring from the alkaline catalyst.

In response to this argument, it is argued that the only step of the claimed method is neutralizing the gelling agent with an effective amount of the topical composition, and example 2, col.11-12, teaches mixing gel composition which is components A and B with jojoba wax component C and with component D which is neutralizing agent. Component A that comprises EDTA and component D that comprises triethanolamine will bring pH of the composition to neutral state having pH between 6.8-7.2. Hence the reference does not teach away from the instantly claimed method. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the

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applicant." *In re Gurley*, 27 F.3d 551,553 (Fed. Cir. 1994). In the instant case, one having ordinary skill in the art would not have been discouraged from having neutral composition, especially the reference teaches neutral pH is useful.

In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

It has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int 'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine



the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. KSR

INTERNATIONAL CO. v. TELEFLEX INC. ET AL. (2007).

Finally, it is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter as a whole as defined by the claims would have been prima facie obvious within the meaning of 35 U.S.C. 103 (a).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isis A Ghali/  
Primary Examiner, Art Unit 1611

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